



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,581	06/11/2001	Susumu Nakagawa	450100-03278	2762
20999 7590 11/27/2007 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER SHELEHEDA, JAMES R	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 11/27/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/878,581

Applicant(s)

NAKAGAWA, SUSUMU

Examiner

James Sheleheda

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22, 28-30 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22, 28-30 and 32-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/19/07 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to the rejections under Goodman and Garfinkle have been considered but are moot in view of the new ground(s) of rejection.

3. Applicant's arguments with respect to the rejections under Aras and Zigmond have been fully considered but they are not persuasive.

On page 20, applicant argues that Aras fails to disclose attaching a content owner identifier to image content.

In response, Aras explicitly indicates wherein the embedded AVI codes attached to the image content (column 7, lines 30-67) will include a content owner identifier (see Table II under column 10). Therefore, applicant's arguments are not convincing.

On page 23, applicant argues that Zigmond fails to disclose "selecting an advertisement image based upon viewer information and selecting the advertisement or rejection thereof" as claimed.

In response, Zigmond specifically discloses wherein the advertisement selection is based upon viewer information, as the ads are targeted based upon viewer information, such as demographics and viewing history (column 13, lines 7-14 and column 14, lines 49-58). This clearly meets the claim limitation of "selecting an advertisement image based upon viewer information", as recited in the claim.

Furthermore, it is noted that the claim limitations of "select said advertisement" or "reject said advertisement..." are presented in the alternative and therefore are not both required to meet the claim.

Zigmond clearly discloses wherein the user will select the advertisement for display (column 9, lines 30-38 and column 16, line 65-column 17, line 9), thus clearly meeting the claim limitation of "a viewer can select an advertisement".

Additionally, as Zigmond clearly discloses wherein multiple ads are presented for the display (column 9, lines 30-38 and column 16, line 65-column 17, line 9) and wherein the viewer will choose one ad as being of greater interest than another ad (column 17, lines 1-9), Zigmond clearly meets the limitation of rejecting said advertisement, as the less desirable advertisement has been rejected in favor of an ad of greater interest. Therefore, applicant's arguments are not persuasive.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-21, 28, 29 and 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hite (US 5,774,170) (of record) in view of Aras (US 5,872,588) (of record), Khoo (6,434,747) and Zigmond (US 6,698,020) (of record).

Regarding claim 1, Hite discloses that the claimed "image content providing method of providing an image content from an image content providing apparatus to an image content reproducing apparatus" is met as follows:

The claimed step of requesting to distribute said image content from said image content reproducing apparatus to said image content providing apparatus" is met by column 7, lines 54-63, which disclose a consumer request for programming which can begin at any time. The consumer location meets the claimed reproducing apparatus and the server meets the claimed content providing apparatus.

- The claimed step of transmitting said image content to said image content reproducing apparatus and detecting a position of inserting an advertisement image in said image content at said image content providing apparatus" is met by the routing of the requested video to the individual consumer display device. Detecting a position of inserting an advertisement image is met by the commercial choice being switched to that location based on a match of the CID (Commercial Identifier) determined for that

location and the CID embedded in the commercial. The matching can occur at the display site [col. 7, lines 54-63]. • The claimed step of requesting an advertisement image providing apparatus having said advertisement image to distribute said advertisement image from said image content providing apparatus" is met by column 6, lines 28-33, which disclose that the display site tunes to the frequency which contains the commercial being sent from the server if the CID code in the commercial and the CID code in the RD (Recording Device for recording CID codes that tell the display which commercials to display and which commercials to ignore) match.

• The claimed step of "selecting said advertisement image to be inserted to said image content and transmitting thereof to said image content providing apparatus at said advertisement image providing apparatus" is, again, met by column 6, lines 28-33, which disclose that the display site tunes to the frequency which contains the commercial being sent from the server if the CID code in the commercial and the CID code in the RD match. • The claimed step of distributing said advertisement image at the position of inserting said advertisement image when said image content is distributed from said image content providing apparatus to said image content reproducing apparatus" is met by the transmission of a default commercial in case a targeted commercial is not played in place of the default commercial. Depending on the capacity of the transmission system, the number of simultaneous commercials could be relatively small...or much larger [col. 6, lines 3-9].

However, Hite fails to disclose registering said image content by attaching a content owner identifier; and distributing an advertisement insertion charge to a content owner based on the content owner identifier.

Aras discloses that the "content owner identifier is attached to said image content" by adding tag information to the program being watched (for example, adding an audio-visual identifier, or AVI, to a program, col. 7, lines 30-54 and cols. 8 and 9, lines 53-67 and 1-2, and Table II).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the content owner identification of image content of Aras, an analogous art, to the image content providing method of Hite to further identify the image content being reproduced for the user (column 7, lines 31-67).

Khoo, in an analogous art, discloses the claimed step "distributing an advertisement insertion charge to a content owner" (column 1, lines 10-30), to ensure that content providers are reimbursed for their content.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the distributing an advertisement insertion charge to a content owner of Khoo, an analogous art, to the image content providing method of Hite and Aras to ensure that content providers are reimbursed for their content.

Hite, Aras and Khoo do not disclose selecting an advertisement image based on viewer information set at the image content reproducing apparatus such that a viewer can select advertisement image or reject said advertisement image and select a different category.

Zigmond discloses selecting an advertisement image based on viewer information set at the image content reproducing apparatus such that a viewer can select advertisement image or reject said advertisement image and select a different category (such as by choosing from multiple ads, some being for different categories or products, col. 9, lines 30-38).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the ad selection of Zigmond, an analogous art, to the image content providing method of Hite, Aras and Khoo so that advertising effectiveness is maximized and the viewer's time is not wasted.

Regarding claim 2, Hite further discloses that the claimed "image content providing method according to claim 1, wherein when said image content is requested to distribute at said image content reproducing apparatus, said image content is selected and requested to distribute based on a title list which is information for viewing said distributable image contents to be transmitted from said image content providing apparatus" is met by the VOD (Video On Demand) functionality discussed on column 7, lines 54-63, which inherently allows users to select programming from a title list that is transmitted to the display site before transmission of the Video.

Regarding claim 3, Hite further discloses that the claimed "image content providing method according to claim 1, wherein the position of said image content for inserting said advertisement image is detected based on advertisement inserting condition data



having an advertisement image inserting position condition for designating the position of inserting said advertisement image and an advertisement image selecting condition for designating a category of said advertisement image capable of being inserted to said image content" is met by the conditions and rules for displaying the commercial [col. 7, lines 7-9].

Regarding claim 4, Hite further discloses that the claimed "image content providing method according to claim 3, wherein said advertisement inserting condition data includes an advertisement image reproducing condition for designating a maximum period of time for reproducing said advertisement image when said advertisement image is inserted to said image content" is met by the time period disclosed in column 7, lines 22-23. In other words, addressable ads are run for a time period that is designated according to a targeted addressable ad spot.

Regarding claim 5, Hite further discloses that the claimed "image content providing method according to claim 3, wherein when said advertisement image is requested to distribute at said image content providing apparatus, said advertisement inserting condition data is transmitted to said advertisement image providing apparatus and when said advertisement image is selected at said advertisement image providing apparatus, said advertisement image is selected based on said advertisement inserting condition data" is met, again, by the conditions and rules for displaying the commercial. The codes of the commercials transmitted are first compared to the codes previously

stored. The commercial transmitted that is found to match is stored in the storage at the display site. Note that the CIDs and display rules would be stored in a storage known as an Ad Queue in the commercial processor [col. 7, lines 7-14].

Regarding claim 6, Hite further discloses that the claimed "image content providing method according to claim 1, wherein when said image content is requested to distribute at said image content reproducing apparatus, viewer information of a viewer for utilizing said image content is transmitted to said image content providing apparatus" is met by the fact that the characteristics of those viewing or hearing the commercials are analyzed and categorized and the results are stored in a Customer Database 128 [col. 9, lines 44-57].

Regarding claim 7, Hite further discloses that the claimed "image content providing method according to claim 6, wherein when said advertisement image is requested to distribute at said image content providing apparatus, said viewer information is transmitted to said advertisement image providing apparatus and when said advertisement image is selected at said advertisement image providing apparatus, said advertisement image is selected based on said viewer information" is met by the programming being analyzed and categorized to determine the suitability of insertion of different categories of commercials [col. 9, lines 44-57]. Also, the Programming Database 152 contains lists of programs would be suitable and eligible for use with

commercials which match the needs and wants of consumers in the Consumer Database 128 [col. 11, lines 13-18].

Regarding claim 8, Hite further discloses that the claimed "image content providing method according to claim 1" is further met as follows:

- The claimed "main image content distributing apparatus" is met by the Media Origination Facility 300.
- The claimed "plurality of deputy image content distributing apparatus" is met by Ad Administration and Transmission Facilities 100 and 200.
- The claimed "wherein said main image content distributing apparatus selects one of the deputy image content distributing apparatus from said plurality of deputy image content distributing apparatus by a request of distributing said image content from said image content reproducing apparatus and said selected deputy image content distributing apparatus distributes said image content to said image content reproducing apparatus" is met by the fact that the Ad Administration Facility 100 is where customers, commercials, and programs are analyzed and categorized and the results are stored in databases. The information is then transmitted to the Ad Transmission Facility 200, which then sends the processed commercials and CID codes with other video and/or audio programming to the Media Origination Facility 300. The Media Origination Facility 300 then sends the processed commercials and CID codes to the display site 400 at user request (as discussed previously) [col. 8, line 65 - col. 9, line 33].

Regarding claim 9, Hite further discloses that the claimed "image content providing method according to claim 1" is further met as follows:

- The claimed "main image content distributing apparatus" is met by the Media Origination Facility 300.
- The claimed "plurality of image content distribution splitter nodes, wherein when said main image content distributing apparatus is requested to distribute said image content, said main image content distributing apparatus selects said image content distribution splitter node and distributes said image content to said image content distribution splitter node and said image content is distributed from said image content distribution splitter node to said image content reproducing apparatus" is met by the proposed use of the method of commercial substitution in a geographical node system [col. 3, lines 4-10].

Regarding claim 10, see the above rejection to similar method claim 1.

Regarding claim 11 see the above rejection to similar method claim 2.

Regarding claim 12, see the above rejection to similar method claim 3.

Regarding claim 13, see the above rejection to similar method claim 4.

Regarding claim 14, see the above rejection to similar method claim 5.

Regarding claim 15, see the above rejection to similar method claim 7.

Regarding claim 16, Hite further discloses that the claimed "image content providing method according to claim 11, wherein said image content is provided by said

image content providing apparatus by subjecting said image content to download distribution to said image content reproducing apparatus" is met by the download of the programming and processed commercials and CID codes via electrical and/or optical links 303, radio transmission 302 and 401, or satellite 202 [col. 9, lines 32-38].

Regarding claim 17, Hite further discloses that the claimed "image content providing method according to claim 11, wherein said image content is provided by said image content providing means by transmitting an information recording medium recorded with said image content to said image content reproducing apparatus" is met by the transmission of the programming and processed commercials and CID codes via physical means 307 such as optical or magnetic tapes or disks [col. 9, lines 32-38].

Regarding claim 18, Hite discloses that the claimed "image content providing system" is met as follows:

- The claimed "image content providing apparatus having an image content and having a function of providing said image content" is met by the Media Origination Facility 300 for sending programming and commercials to display site 400 [col. 9, lines 28-33].
- The claimed "advertisement image providing apparatus having an advertisement image to be inserted to said image content and having a function of providing said advertisement image" is met by the Ad Transmission Facility 200, which combines the commercials and CID codes with other video and audio programming and conveys it to

the Media Origination Facility for sending to the display site 400 [col. 9, lines 16-20]. •

The claimed "image content reproducing apparatus having a function of reproducing said image content and said advertisement image; wherein said image content providing apparatus has a function of inserting the advertisement image transmitted from said advertisement image providing apparatus to said image content and providing said image content and said advertisement image to said image content reproducing apparatus" is met by the transmission of a default commercial in case a targeted commercial is not played in place of the default commercial. Depending on the capacity of the transmission system, the number of simultaneous commercials could be relatively small...or much larger [col. 6, lines 3-9]. However, Hite fails to disclose registering said image content by attaching a content owner identifier to said image content; and distributing an advertisement insertion charge to a content owner based on the content owner identifier.

Aras discloses that the "content owner identifier is attached to said image content" by adding tag information to the program being watched (for example, adding an audio-visual identifier, or AVI, to a program, col. 7, lines 30-54 and cols. 8 and 9, lines 53-67 and 1-2, and Table II).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the content owner identification of image content of Aras, an analogous art, to the image content providing method of Hite to further identify the image content being reproduced for the user (column 7, lines 31-67).

Khoo, in an analogous art, discloses the claimed step "distributing an advertisement insertion charge to a content owner" (column 1, lines 10-30), to ensure that content providers are reimbursed for their content.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the distributing an advertisement insertion charge to a content owner of Khoo, an analogous art, to the image content providing method of Hite and Aras to ensure that content providers are reimbursed for their content.

Hite, Aras and Khoo do not disclose selecting an advertisement image based on viewer information set at the image content reproducing apparatus such that a viewer can select advertisement image or reject said advertisement image and select a different category.

Zigmond discloses selecting an advertisement image based on viewer information set at the image content reproducing apparatus such that a viewer can select advertisement image or reject said advertisement image and select a different category (such as by choosing from multiple ads, some being for different categories or products, col. 9, lines 30-38).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the ad selection of Zigmond, an analogous art, to the image content providing method of Hite, Aras and Khoo so that advertising effectiveness is maximized and the viewer's time is not wasted.

Regarding claim 19, see the above rejection for similar claim 18.

Regarding claim 20, Hite discloses that the claimed "image content providing apparatus for providing an image content" is met as follows:

- The claimed "image content database for storing said image content" is met by the Programming Database 152, for storing programs that would be suitable and eligible for use with commercials which match the needs and wants of consumers [col. 11, lines 12-15]. Also, the VOD systems discussed in column 7, lines 54-63 contains massive storage systems called servers for storing programming.
- The claimed "list forming means having a function of forming a title list which is information of viewing said image content stored to said image content database and providing said title list" is met by the VOD (Video On Demand) functionality discussed on column 7, lines 54-63, which inherently allows users to select programming from a title list that is transmitted to the display site before transmission of the video.
- The claimed "image providing means having a function of inserting an advertisement image to said image content of said image database and distributing thereof is met by column 6, lines 28-33, which disclose that the display site tunes to the frequency which contains the commercial being sent from the server if the CID code in the commercial and the CID code in the RD match.

However, Hite fails to disclose database registering means for attaching a content owner identifier to said image content; and wherein an advertisement insertion charge is distributed to a content owner based on the content identifier.



Aras discloses that the "content owner identifier is attached to said image content" by adding tag information to the program being watched (for example, adding an audio-visual identifier, or AVI, to a program, col. 7, lines 30-54 and cols. 8 and 9, lines 53-67 and 1-2, and Table II).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the content owner identification of image content of Aras, an analogous art, to the image content providing method of Hite to further identify the image content being reproduced for the user (column 7, lines 31-67).

Khoo, in an analogous art, discloses the claimed step "distributing an advertisement insertion charge to a content owner" (column 1, lines 10-30), to ensure that content providers are reimbursed for their content.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the distributing an advertisement insertion charge to a content owner of Khoo, an analogous art, to the image content providing method of Hite and Aras to ensure that content providers are reimbursed for their content.

Hite, Aras and Khoo do not disclose selecting an advertisement image based on viewer information set at the image content reproducing apparatus such that a viewer can select advertisement image or reject said advertisement image and select a different category.

Zigmond discloses selecting an advertisement image based on viewer information set at the image content reproducing apparatus such that a viewer can select advertisement image or reject said advertisement image and select a different

category (such as by choosing from multiple ads, some being for different categories or products, col. 9, lines 30-38).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the ad selection of Zigmond, an analogous art, to the image content providing method of Hite, Aras and Khoo so that advertising effectiveness is maximized and the viewer's time is not wasted.

Regarding claim 28, Hite discloses that the claimed "program storage medium stored with an image content providing program which is a program storage medium stored with an image content providing program for providing an image content" is met as follows:

- The claimed "list forming means having a function of forming a title list constituting information of viewing said image content stored to said image content database and providing said title list" is met by the VOD (Video On Demand) functionality discussed on column 7, lines 54-63, which inherently allows users to select programming from a title list that is transmitted to the display site before transmission of the video.
- The claimed "image providing means having a function of inserting an advertisement image to said image content of said image content database and distributing thereof" is met by column 6, lines 28-33, which disclose that the display site tunes to the frequency which contains the commercial being sent from the server if the CID code in the commercial and the CID code in the RD match.

However, Hite fails to disclose database registering means for attaching a content owner identifier to said image content; and wherein an advertisement insertion charge is distributed to a content owner based on the content identifier.

Aras discloses that the "content owner identifier is attached to said image content" by adding tag information to the program being watched (for example, adding an audio-visual identifier, or AVI, to a program, col. 7, lines 30-54 and cols. 8 and 9, lines 53-67 and 1-2, and Table II).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the content owner identification of image content of Aras, an analogous art, to the image content providing method of Hite to further identify the image content being reproduced for the user (column 7, lines 31-67).

Khoo, in an analogous art, discloses the claimed step "distributing an advertisement insertion charge to a content owner" (column 1, lines 10-30), to ensure that content providers are reimbursed for their content.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the distributing an advertisement insertion charge to a content owner of Khoo, an analogous art, to the image content providing method of Hite and Aras to ensure that content providers are reimbursed for their content.

Hite, Aras and Khoo do not disclose selecting an advertisement image based on viewer information set at the image content reproducing apparatus such that a viewer can select advertisement image or reject said advertisement image and select a different category.

Zigmond discloses selecting an advertisement image based on viewer information set at the image content reproducing apparatus such that a viewer can select advertisement image or reject said advertisement image and select a different category (such as by choosing from multiple ads, some being for different categories or products, col. 9, lines 30-38).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the ad selection of Zigmond, an analogous art, to the image content providing method of Hite, Aras and Khoo so that advertising effectiveness is maximized and the viewer's time is not wasted.

Regarding claim 21, Hite discloses that the claimed "advertisement image providing apparatus having an advertisement image and providing said advertisement image" is met as follows:

- The claimed "advertisement image database for storing said advertisement image" is met by the Ad Administration Facility 100, which stores commercials and programs for analysis and categorization. The results of which are stored in a database [col. 8, line 65 - col. 9, line 2].
- The claimed "advertisement image selecting means for selecting said advertisement image to be provided from said advertisement image database" is met by column 6, lines 28-33, which disclose that the display site tunes to the frequency which contains the commercial being sent from the server if the CID code in the commercial and the CID code in the RD match.
- The claimed "advertisement image providing means

having a function of providing said advertisement image selected by said advertisement image selecting means and generating an advertisement providing log which is history information when said advertisement image is selected" is met by the transmission of a default commercial in case a targeted commercial is not played in place of the default commercial. Depending on the capacity of the transmission system, the number of simultaneous commercials could be relatively small...Or much larger [col. 6, lines 3-9]. Also, the Ad Administration Facility 100 contains Customer Database 128, which stores a list of viewer information regarding viewed and possible future commercial interests [col. 10, lines 54-58].

- The claimed "advertisement providing log database for storing said advertisement providing log" is, again, met by the Customer Database 128, which stores a list of viewer information regarding viewed and possible future commercial interests [col. 10, lines 54-58].

However, Hite fails to disclose an advertisement database registering means for attaching an advertisement identifier to said advertisement image; and wherein an advertisement insertion charge is distributed to a content owner based on the advertisement identifier.

Aras discloses that the "content owner identifier is attached to said image content" by adding tag information to the program being watched (for example, adding an audio-visual identifier, or AVI, to a program, col. 7, lines 30-54 and cols. 8 and 9, lines 53-67 and 1-2, and Table II).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the content owner identification of image content of Aras, an analogous art, to the image content providing method of Hite to further identify the image content being reproduced for the user (column 7, lines 31-67).

Khoo, in an analogous art, discloses the claimed step "distributing an advertisement insertion charge to a content owner" (column 1, lines 10-30), to ensure that content providers are reimbursed for their content.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the distributing an advertisement insertion charge to a content owner of Khoo, an analogous art, to the image content providing method of Hite and Aras to ensure that content providers are reimbursed for their content.

Hite, Aras and Khoo do not disclose selecting an advertisement image based on viewer information set at the image content reproducing apparatus such that a viewer can select advertisement image or reject said advertisement image and select a different category.

Zigmond discloses selecting an advertisement image based on viewer information set at the image content reproducing apparatus such that a viewer can select advertisement image or reject said advertisement image and select a different category (such as by choosing from multiple ads, some being for different categories or products, col. 9, lines 30-38).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the ad selection of Zigmond, an analogous art, to the image

content providing method of Hite, Aras and Khoo so that advertising effectiveness is maximized and the viewer's time is not wasted.

Regarding claim 29, Hite discloses that the claimed "program storage medium stored with an advertisement image providing program which is a program storage medium stored with an advertisement image providing program for providing an advertisement image" is met as follows:

- The claimed "advertisement image selecting means for selecting said advertisement image to be provided from an advertisement image database" is met by column 6, lines 28-33, which disclose that the display site tunes to the frequency which contains the commercial being sent from the server if the CID code in the commercial and the CID code in the RD match.
- The claimed "advertisement image providing means having a function of providing said advertisement image selected by said advertisement image selecting means and generating an advertisement providing log constituting history information in providing said advertisement image" is met by the transmission of a default commercial in case a targeted commercial is not played in place of the default commercial. Depending on the capacity of the transmission system, the number of simultaneous commercials could be relatively small...or much larger [col. 6, lines 3-9]. Also, the Ad Administration Facility 100 contains Customer Database 128, which stores a list of viewer information regarding viewed and possible future commercial interests [col. 10, lines 54-58]. However, Hite fails to disclose an advertisement database registering means for

attaching an advertisement identifier to said advertisement image; and wherein an advertisement insertion charge is distributed to a content owner based on the advertisement identifier.

Aras discloses that the "content owner identifier is attached to said image content" by adding tag information to the program being watched (for example, adding an audio-visual identifier, or AVI, to a program, col. 7, lines 30-54 and cols. 8 and 9, lines 53-67 and 1-2, and Table II).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the content owner identification of image content of Aras, an analogous art, to the image content providing method of Hite to further identify the image content being reproduced for the user (column 7, lines 31-67).

Khoo, in an analogous art, discloses the claimed step "distributing an advertisement insertion charge to a content owner" (column 1, lines 10-30), to ensure that content providers are reimbursed for their content.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the distributing an advertisement insertion charge to a content owner of Khoo, an analogous art, to the image content providing method of Hite and Aras to ensure that content providers are reimbursed for their content.

Hite, Aras and Khoo do not disclose selecting an advertisement image based on viewer information set at the image content reproducing apparatus such that a viewer can select advertisement image or reject said advertisement image and select a different category.



Zigmond discloses selecting an advertisement image based on viewer information set at the image content reproducing apparatus such that a viewer can select advertisement image or reject said advertisement image and select a different category (such as by choosing from multiple ads, some being for different categories or products, col. 9, lines 30-38).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the ad selection of Zigmond, an analogous art, to the image content providing method of Hite, Aras and Khoo so that advertising effectiveness is maximized and the viewer's time is not wasted.

Regarding claims 32 and 34, Hite discloses wherein said image content is a moving picture (video; column 3, lines 29-35 and column 5, lines 29-50).

Regarding claims 33 and 35, Hite discloses wherein said image content is a drama (column 4, lines 41-45).

Regarding claim 36, see the above rejection for similar claim 1, as Hite discloses wherein the image content is a moving picture (video; column 3, lines 29-35 and column 5, lines 29-50).

Regarding claim 37, see the above rejection for similar claim 18, as Hite discloses wherein the image content is a moving picture (video; column 3, lines 29-35 and column 5, lines 29-50).

6. Claims 22 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hite (US 5,774,170) in view of Aristides (US 5,630,119) and Zigmond.

Regarding claim 22, Hite discloses that the claimed "image content reproducing apparatus for reproducing an image content" is met as follows:

- The claimed "image acquiring means for acquiring said image content and acquiring an advertisement image inserted to said image content" is met by the routing of the requested video to the individual consumer display device. Detecting a position of inserting an advertisement image is met by the commercial choice being switched to that location based on a match of the CID (Commercial Identifier) determined for that location and the CID embedded in the commercial. The matching can occur at the display site [col. 7, lines 54-63]. Also, the insertion of the advertisement into the image content is met by the transmission of a default commercial in case a targeted commercial is not played in place of the default commercial. Depending on the capacity of the transmission system, the number of simultaneous commercials could be relatively small or much larger [col. 6, lines 3-9].
- The claimed "image reproducing means having a function of reproducing said image content acquired by said image acquiring means and inserting said advertisement image to said image content based on an advertisement inserting condition data and reproducing thereof" is met by the conditions

and rules for displaying the commercial instead of the preemptable commercial that is delivered along with the video programming [col. 7, lines 7-14].

Hite, however, fails to disclose an image content selecting means for requesting distribution of a title list to an image content providing apparatus according to an inputted instruction and acquiring said title list.

Aristides discloses the claimed means "an image content selecting means for requesting distribution of a title list to an image content providing apparatus according to an inputted instruction and acquiring said title list" (Fig. 1; column 6, lines 1-43) and displaying a listing of video products (Fig. 2).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the title list of Aristides, an analogous art, to the image content providing method of Hite to more efficiently distribute needed program listings which are currently available (column 6, lines 20-43 and column 1, line 46-column 2, line 21).

Hite and Aristides do not disclose selecting an advertisement image based on viewer information set at the image content reproducing apparatus such that a viewer can select advertisement image or reject said advertisement image and select a different category.

Zigmond discloses selecting an advertisement image based on viewer information set at the image content reproducing apparatus such that a viewer can select advertisement image or reject said advertisement image and select a different category (such as by choosing from multiple ads, some being for different categories or products, col. 9, lines 30-38).

At the time Of invention, it would have been obvious to a person of ordinary skill in the art to combine the ad selection of Zigmond, an analogous art, to the image content providing method of Hite and Aristides so that advertising effectiveness is maximized and the viewer's time is not wasted.

Regarding claim 30, Hite discloses that the claimed "program storage medium stored with an image content reproducing program which is a program storage medium stored with an image content reproducing program for reproducing an image content" is met as follows:

- The claimed "image acquiring means for acquiring said image content and acquiring an advertisement image to be inserted to said image content" is met by the routing of the requested video to the individual consumer display device. Detecting a position of inserting an advertisement image is met by the commercial choice being switched to that location based on a match of the CID (Commercial Identifier) determined for that location and the CID embedded in the commercial. The matching can occur at the display site [col. 7, lines 54-63]. Also, the insertion of the advertisement into the image content is met by the transmission of a default commercial in case a targeted commercial is not played in place of the default commercial. Depending on the capacity of the transmission system, the number of simultaneous commercials could be relatively small...or much larger [col. 6, lines 3-9].
- The claimed "image reproducing means having a function of reproducing the image content acquired by said image acquiring means and inserting said advertisement image to said image content based on

advertisement inserting condition data and reproducing thereof is met by the conditions and rules for displaying the commercial instead of the preemptable commercial that is delivered along with the video programming [col. 7, lines 7-14].

Hite, however, fails to disclose an image content selecting means for requesting distribution of a title list to an image content providing apparatus according to an inputted instruction and acquiring said title list.

Aristides discloses the claimed means "an image content selecting means for requesting distribution of a title list to an image content providing apparatus according to an inputted instruction and acquiring said title list" (Fig. 1; column 6, lines 1-43) and displaying a listing of video products (Fig. 2).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the title list of Aristides, an analogous art, to the image content providing method of Hite to more efficiently distribute needed program listings which are currently available (column 6, lines 20-43 and column 1, line 46-column 2, line 21).

Hite and Aristides do not disclose selecting an advertisement image based on viewer information set at the image content reproducing apparatus such that a viewer can select advertisement image or reject said advertisement image and select a different category.

Zigmond discloses selecting an advertisement image based on viewer information set at the image content reproducing apparatus such that a viewer can select advertisement image or reject said advertisement image and select a different

category (such as by choosing from multiple ads, some being for different categories or products, col. 9, lines 30-38).

At the time Of invention, it would have been obvious to a person of ordinary skill in the art to combine the ad selection of Zigmond, an analogous art, to the image content providing method of Hite and Aristides so that advertising effectiveness is maximized and the viewer's time is not wasted.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jennings (7,054,949) disclosing that content owners receive payments from advertisers.

Corts et al. (US 2002/0141491 A2) disclosing that content owners receive payments from advertisers.

8. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

### **Certificate of Mailing**

Application/Control Number:  
09/878,581  
Art Unit: 2623

Page 30

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

on \_\_\_\_\_  
(Date)

Typed or printed name of person signing this certificate:

\_\_\_\_\_

Signature: \_\_\_\_\_

Registration Number: \_\_\_\_\_

### **Certificate of Transmission**

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. ( ) \_\_\_\_\_ - \_\_\_\_\_ on \_\_\_\_\_  
(Date)

Typed or printed name of person signing this certificate:

\_\_\_\_\_

Signature: \_\_\_\_\_

Registration Number: \_\_\_\_\_

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda whose telephone number is (571) 272-7357. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James Sheleheda  
Patent Examiner  
Art Unit 2623

JS

  
CHRIS KELLEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600